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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,153	11/25/2003	Masaru Kohno	0229-0783P	4152

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,153

Applicant(s)

KOHNO, MASARU

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/25/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The substitute specification, claims and abstract are agreed with and have been approved and the objection under 37 C.F.R. rule 1.71 as stated on 26 October 2004 has been removed.
2. The specification is objected under 37 C.F.R. rule 1.71 as to not being written in a clear way to be enabling to one skilled in the art to make the same. Page 5 lines 2-9 do not make sense in that they state, "In order to set the face angle to 0 degree, the face angle is adjusted by rotating the head around the center axis CL of the shaft axis such that a horizontal tangential line in contact with an area center of gravity FC of the face surface 2 is parallel to a vertical plane VP1, as shown in figure 4." It seems that tangent line will always be parallel to a plane VP1 since the face is fixed to the hosel. In addition it is not understood what is a face angle being zero.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood how a shaft axis is arranged in a vertical plane and a face angle is set to zero. Figure 3 shows the shaft axis plane being vertical and the face angle not being set zero but showing a positive loft angle.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bliss in view of Oonuki.

Bliss discloses a horizontal tangential line passing through an area center of gravity of the face surface and being in contact with the face surface in the form of an idealized planar face such that a tangent line parallel to line "h" would exist directly in front of the center of gravity on the same horizontal plane and it would intersecting a perpendicular line dropped to a tangential line from a sweet spot (as defined in the

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specification (where the line from the center of gravity of a head is perpendicular to the face) being arranged on a tangential line within 2 mm from an area center of gravity close to a toe and within 4 mm close to a heel in the form of the intersection would be directly at the projection point of the center of gravity on the face at same horizontal plane of the center of gravity but below the sweet spot (0 mm) (Fig. 2, Col. 3, Lns. 35-60).

Bliss lacks the shortest distance between the center of gravity of the head to the center line of the shaft axis being 47-48 mm. Oonuki discloses the shortest distance between the center of gravity of the head to the center line of the shaft axis being 47-48 mm (Fig. 66, Col. 2, Lns. 23-35). In view of the patent of Oonuki it would have been obvious to modify the head of Bliss to have the shortest distance between the center of gravity of the head to the center line of the shaft axis being 47-48 mm in order to utilize a dimension which is used in the art in designing a golf head and in order to form a large volume head with a shaft near the heel to play a round of golf with.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bliss as applied to claim 1 above, and further in view of Evans.

Bliss lacks a head volume being equal or more than 300 cm³. Evans discloses a metal head having a volume being more than 300 cm³ (Col. 3, Lns. 66-67). In view of the patent of Evans it would have been obvious to modify the head of Bliss to have a head volume being more than 300 cm³ in order to have a head with a large face and sweet spot when hitting a ball.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 27 May 2005


STEPHEN BLAU
PRIMARY EXAMINER